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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026.629	12/27/2001	Patrick Caceres	102549.01	8010

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EXAMINER

DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

6

DATE MAILED: 09/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-6

Office Action Summary

Application No.

10/026,629

Applicant(s)

CACERES ET AL.

Examiner

Tamra L. Dicus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-18, 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

This Office Action is responsive to the amendment filed 6-25-03. The objection is withdrawn. The 112 rejection is withdrawn except to claims 6-7 and 19-20. The 102(b) rejection is withdrawn. Cancellation of claims 6 and 19 are acknowledged.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 7-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,669,894 to Goldman et al. in view of USPN 6,075,177 to Bahia et al.
3. Goldman teaches an absorbent member comprising a permeable (nonwatertight) nonwoven thermoplastic fibers and fibrous materials which form an envelope having walls. The fibrous materials include naturally occurring fibers of cotton, or synthetic fibers of polyesters. See col. 21, lines 20-55 and col. 42, lines 1-8. The fibers may be of single or combined polyethylene, polyester, PET, polypropylene, hydrophilic or hydrophobic see col. 26, lines 10-35, and col. 37, lines 20-49. The fibers have various lengths and may be short or long synthetic fibers with hydrophilic surfaces of cross-linked cellulose, polypropylene, polyester, and many others. See col. 36, lines 34-55 and col. 37, lines 55-65. A hydrogel-forming absorbent polymer

such as sodium polyacrylate is within the envelope. See col. 31, lines 40-65, col. 32, lines 1-15, lines 55-65, col. 40, lines 35-55, Example 3, col. 17, lines 1-28, Table 1, col. 22, lines 30-41.

Per Applicant's disclosure that the polymer absorbent is sodium polyacrylate, Goldman's same material, inherently is a "core/shell" polymer and inherently functions the same, e.g. "in particulate form...comprises a core of less cross-linked...". Goldman includes the same materials in his absorbent member, hence, the envelope being collapsible is inherently provided.

Goldman does not teach a viscose fiber (claims 4-5, 10, 12, 16, 18). Bahia teaches a wound dressing. At col.3, lines 40-43, Bahia teaches a viscose rayon or viscose cotton fiber. Bahia further teaches several different viscose fibers are derived from cellulose depending upon the absorbency and tenacity required. Hence it would have been obvious to one of ordinary skill in the art to modify the absorbent members of Goldman to further include viscose fibers since Bahia teaches doing so provides an absorbent nonwoven material with varying degrees of absorbency and tenacity at col. 3, lines 40-60.

4. Goldman does not explicitly teach the longer fibers of viscose. However, as Goldman explained above, fibers can be of any length. Since Bahia teaches viscose fibers as a suitable fiber in a nonwoven absorbent material, it would have been obvious to one of ordinary skill in the art to modify the absorbent of Goldman to provide a viscose fiber of longer fibers since Bahia teaches providing a viscose fiber to vary absorbency.

Goldman does not explicitly teach viscose fibers from 70 to 90% in the total weight of the nonwoven fabric (claims 8, 12, and 18). Goldman, however, teaches at col. 36, lines 24-25 that fibers may be present from 10 to 90% in order to produce desired properties for absorbency. Hence it would have been obvious to one of ordinary skill in the art to modify the absorbent

member of Goldman to vary the percentages of fibers, be it viscose or polyester, or polypropylene since Goldman teaches varying the weight percentage by blending fibers with cellulose for example, results in a high compressive modulus, improving performance at col. 36, lines 45-65. Additionally, Bahia teaches viscose fibers may be used in a cellulose and nonwoven as cited above. Moreover, weight percentage of fibers are optimizable, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272.

5. Regarding claims 1, 7, 14, and 20, the Examiner takes the position that since the polymer absorbent particles are the same (sodium acrylate), then how they react in excess or theoretical weight is inherent. Further these claims are based on process limitations which are not given any weight in product claims. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F.2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re Brown*, 459 F.2d 531.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,669,894 to Goldman et al. in view of USPN 6,075,177 to Bahia et al., or USPN 5,147,646 to Graham. Regarding method for relieving pain of claim 13, Goldman does not teach this method. However, Bahia teaches a wound dressing and at col. 2, lines 30-50 applying it to heal wounds (relieve pain). Since the same materials are used in Bahia as in Goldman, the function ("particles with water...through envelope...water vapor desorbed...") would be the same. Hence, it would

have been obvious to one of ordinary skill in the art to modify Goldman's absorbent material to relieve pain since Bahia/ teaches absorbent materials may be used to heal wounds. Also Graham teaches a hydrogel containing envelopes in a pouch, where hydrogel is swollen when it is immersed and contacts water. The hydrogel absorbs the water, causing the hydrogel to swell to fill the envelope. The hydrogel absorbs water through the water-permeable or porous walls (nonwatertight) of the envelope. The pouch is generally used in wound dressings, contacting the wound (sore part on a body). See col. 1, lines 33-50 and col. 2, lines 45-60. Hence, it would have been obvious to one of ordinary skill in the art to use Goldman's absorbent article to relieve pain, and apply the article on a sore part of a body, allowing water vapor to be desorbed from hydrogel particles. Graham teaches in claim 2 a method of treating a patient, which involves applying an article to a patient's body. The fibers in the article of Graham go through the same process as instantly claimed. See col. 7, lines 40-60 and col. 8, lines 25-35.

Response to Arguments

7. Applicant's arguments filed 6-25-03 have been fully considered but they are not persuasive.
8. In response to Applicant's response of the 112 rejection to claims 6-7 and 19-20, it does not matter what previous state the polymer particles were in, but only to the final product. The Examiner strongly suggests simply claiming the weight percent of polymer particles added to make the end product.
9. In response to Applicant's allegation that Claim 1 or 14 is not taught by the prior art, the Examiner does not agree. Once a reference teaching a product appearing to be substantially identical is made the basis of a rejection, and the Examiner presents evidence or reasoning

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tending to show inherency, the burden shifts to the Applicant to show an unobvious difference. The Applicant has not provided any objective evidence to the contrary. The state of the bag or polymers in the bag or the theoretical/excess amount of polymers are not dispositive to patentability of article claims since the process of the particles swelling or not swelling in excess or theoretically are process limitations. Motivation and suggestion to combine the prior art exists because the same materials are provided in the same technological art.

10. Applicant further alleges that the purpose of containing particles in Goldman and Bahia is to swell and retain liquid. The reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990), *cert. denied*, 500 U.S. 904 (1991) (discussed below). Although *Ex parte Levengood*, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Inter. 1993) states that obviousness cannot be established by combining references “without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done” (emphasis added), reading the quotation in context it is clear that while there must be motivation to make the claimed invention, there is no requirement that the prior art provide the same reason as the applicant to make the claimed invention.

11. Applicant contests that the present invention is based in part on the discovery that the specific core-shell structure of the polymer particles confer unexpectedly improved properties to the article. The Applicant has not argued persuasively. The fact that applicant has recognized

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another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

12. Further in regards to claim 13, the instant invention is to a method for relieving pain. Bahia teaches applying a wound dressing to heal wounds. Such teaching is equivalent to the method described in instant claim 13.

13. Applicant further contests that Graham does not teach polymer particles having a core-shell structure. Per Applicant's disclosure that the polymer absorbent is sodium polyacrylate, Goldman's same material, inherently is a "core/shell" polymer and inherently functions the same, e.g. "in particulate form...comprises a core of less cross-linked...".

14. Applicant argues that Bahia and Graham are not intended to be first wetted with water or to provide a barrier to liquid transport. Patentability of an article does not depend upon intentions but to the product made.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all cited prior art teaches the same technological field and application to nonwoven articles having various functions. Request for reconsideration is denied.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is (703) 305-3809. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

September 2, 2003

Tamra L. Dicus
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

